

REMARKS

Claims 1-10 were pending in the application. By this amendment the applicant adds new claims 11-13, canceled claim 5 and amended claims 2-10.

In the Office Action dated February 5, 2003, claims 1-10 were rejected under 35 U.S.C. §112, second paragraph in the subject Office Action. Claims 1-5 and 8-10 were rejected under 35 U.S.C. §102(a or e) or in the alternative under §103(a).

In the Office Action on page 2, paragraph 1 the disclosure was objected to for informalities. It was requested that titles be inserted into the specification and a "Brief Description of the Drawing" be inserted. Applicant has amended the specification in accordance with the requests. In addition, the applicant has amended the drawing page in accordance with 37 CFR 1.84 to comport with the "Brief Description of the Drawing" and provided a substitute drawing inserting the legend "FIG. 1". No new matter has been added by the foregoing amendments. Applicant submits the bases for the objections to the disclosure have been addressed and objections are overcome.

§112 rejections

On page 2, paragraph 2 claims 1-10 were rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Office Action states the "use of the term 'characterized by' is considered to render the claims indefinite since it is not clear if the limitation following the term is required or not. The Office Action also noted

“claim 4 appears to be outside the scope of claim 1 since it allows for any alkaline earth metal oxide.”

In response the applicant notes that the term “characterized” does not appear in claim 1, therefore the applicant traverses the rejection of claim 1 under §112, second paragraph and the rejection should be withdrawn with respect to claim 1.

With respect to claims 2-10, applicant has amended each of these claims by deleting the objected to language “characterized in that” and replacing it with the term “wherein”. On this basis it is respectfully submitted that the foregoing amendments overcome the rejection of claims 2-10.

With respect to claim 4, applicant has amended the claim to more particularly point out what is claimed. It is respectfully submitted that the foregoing amendment overcomes the rejection of claim 4.

The applicant submits the foregoing amendments place the claims in allowable form.

Prior art rejections

In the Office Action. Claims 1-5 and 8-10 were rejected under 35 U.S.C. §102(a or e) as anticipated by or, in the alternative, under §103(a) as obvious over Sugimoto et al. (US 6,458,734 [“the ‘734 patent”]; 6,108,192 [“the ‘192 patent”] and 6,107, 228 [“the ‘228 patent”]) each taken alone.

The applicant traverses the rejections as to each of the references cited.

The ceramic composition of the '192 patent requires lead (col. 3, lines 53-63) and each and every one of the claims of the '192 patent contemplates the inclusion of lead in the composition (col 18, line 30 – col. 20, line 23. Anticipation requires that each and every element of the claimed invention be met in a single reference. Independent claims 1, 8 and 9 of the subject application as filed explicitly exclude lead from the composition. Therefore the applicant requests the rejection on the basis of the '192 patent be withdrawn.

Similarly, the composition of the '228 patent requires bismuth (col. 4, lines 27-37) and each and every claim of the '228 patent includes bismuth. Independent claims 1, 8 and 9 of the subject application as filed explicitly exclude bismuth from the composition. Therefore the applicant requests the rejection on the basis of the '228 patent be withdrawn.

The '734 patent states at col. 2, lines 22-23 and 55-56 that “the glass component is preferably Pb-free glass.” This statement in no way excludes lead from the ceramic component, and clearly contemplates its inclusion. Independent claims 1, 8 and 9 of the subject application as filed explicitly exclude lead from the ceramic composition. Therefore the applicant requests the rejection on the basis of the '734 patent be withdrawn.

Applicant likewise traverses the rejection under §103 over the cited references. It would not have been obvious to one having skill in the art to remove bismuth and/or lead from the composition of the cited references to arrive at the invention of the present

application. Each of the '192 and the '228 patent describe the advantages of the respective elements when employed in a dielectric composition. Specifically, the '192 patent states, "In practice, addition of PbO provides a dielectric ceramic composition having better stabilized characteristics..." (col. 3, lines 58-60). The '228 patent states that "Incorporation of Bi₂O₃ produces a high-frequency dielectric ceramic composition having more stable characteristics and makes the sintering temperature lower" (col. 4, lines 27-31). Neither of these references nor the '734 patent teaches or suggests the removal of lead and/or bismuth from a dielectric composition would be advantageous. Indeed, the '192 and '228 patents teach away from the removal of these elements. Accordingly the applicant requests withdrawal of the rejection of the claims under §103.

In view of the allowability of claim independent claims 1, 8 and 9 the rejections of dependent claims 2-5 and 9 are overcome. Moreover, claims 6 and 7 were not the subject of a prior art rejection and the applicant submits these claims are also in allowable form. The applicant submits that the prior art does not disclose or suggest the subject matter claimed in either claim 6 or claim 7.


New claims 11-13 clearly claim allowable subject matter.

For the foregoing reasons and in light of the amendments made herein the applicant earnestly solicits a Notice of Allowance for all claims pending in the application. The Examiner is encouraged to telephone the undersigned in order to expedite any detail of the prosecution.

The fee of \$84.00 is submitted herewith. The Commissioner is authorized to

charge any deficiency or credit any overpayment to Deposit Account No. 11-0223.

Respectfully submitted,

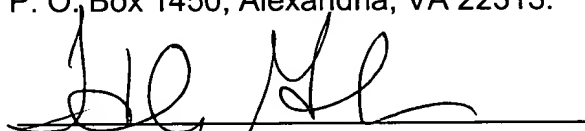

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